

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

SUPPORT FOR THE CLAIM AMENDMENTS

Support for the claim amendments may be found in the specification, for example, on page 14 lines 8-9, page 20 lines 3-9 and FIGS. 3 and 6, as originally filed. Thus, no new matter has been added.

DOUBLE PATENTING

The provisional rejection of claims 1-17 under the judicially created doctrine of obviousness-type double patenting has been obviated by the attached terminal disclaimer and should be withdrawn.

OBJECTION TO THE SPECIFICATION

The objection to the title is respectfully traversed and should be withdrawn.

The objection to the Brief Summary of the Invention section of the application is respectfully traversed and should be withdrawn.

The objection to page 4, line 16 of the specification is respectfully traversed and should be withdrawn.

The objection to the abstract is respectfully traversed and should be withdrawn.

The current title "Programmable Protocol Processing Engine for Network Packet Devices" appears to be indicative of an invention to which the claims are directed. In particular, claim 1 provides (in part) a processing circuit (e.g., programmable protocol processing engine) configured to process at least one first parameter of a network protocol in an incoming packet (e.g., network packets). As such, the objection to the title should be withdrawn.

Regarding the Brief Summary of the Invention, MPEP 608.01(d) states:

Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, **the summary should be directed to the specific invention being claimed...** (emphasis added)

The assertion in the Office Action that the summary "should contain [a] brief description of the disclosed subject matter" does not appear to be consistent with the MPEP text reproduced above. As such, the objection to the Brief Summary of the Invention should be withdrawn.

Regarding page 4, line 16 of the specification, peripherals are a type of circuit. Therefore, "an external circuit" properly describes the subject of the figure. As such,

the objection to page 4, line 16 of the specification should be withdrawn.

Regarding the abstract, the "Guidelines for the Preparation of Patent Abstracts" section in MPEP §608.01(b) appears to be silent regarding (i) disallowing the word "may", (ii) inclusion of "what the applicant has mentioned about the reasoning of the invention" and (iii) "clearly stat[ing] the goal of the invention". Therefore, the Examiner is respectfully requested to either (i) clearly identify the authority for the above assertions or (ii) withdraw the objection.

OBJECTION TO DRAWINGS

The request to label FIG. 1 by a legend such as --Prior Art-- is respectfully traversed and should be withdrawn. FIG. 1 already has the legend "conventional". Adding a second legend would not appear to be useful in understanding the figure.

Regarding FIG. 2, page 13 lines 16-18 of the specification states, "The external circuit 108 may be implemented a[s] one or more circuits 132N-Q. The circuits 132A-Q may be implemented as peripheral blocks or peripheral circuits." Therefore, the "circuits" mentioned on page 5, line 9 are the "External Peripherals" of block 108 shown in FIG. 2. As such, the objection to the drawings should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

The rejection of claims 1-17 under 35 U.S.C. §102(e) as being anticipated by Dietz et al. '725 (hererafter Dietz) is respectfully traversed and should be withdrawn.

The Examiner is respectfully requested to refrain from omnibus rejections that simply list all of the claimed elements and then assert that the claimed elements are disclosed somewhere among a figure and a large section of text (see MPEP 707.07(d)). As such, Applicant's representative respectfully requests that a next rejection (if any) be presented in a non-final Office Action. No reasonable opportunity has been provided to respond to the rejections due to large ambiguities in the current rejections.

Dietz concerns a processing protocol specific information in packets specified by a protocol description language (Title).

Claim 1 provides a database configured to store a pointer for each first parameter of a network protocol. Despite the assertion on page 5 of the Office Action, Dietz appears to be silent regarding a CAM (implied similar to the claimed database) storing pointers for parameters of a network protocol as presently claimed. Furthermore, no application of Dietz to the claim is provided in the Office Action. Therefore, *prima facie* anticipation has not been established.

Claim 1 further provides a processing circuit configured to (i) process at least one of the first parameters in an incoming

packet in accordance with the pointer to produce a second parameter. Despite the assertion on page 5 of the Office Action, Dietz appears to be silent regarding a network monitor 300 (implied similar to the claims processing circuit) processing parameters of incoming packets with a pointer stored in the CAM (implied similar to the claimed database) as presently claimed. Furthermore, no application of Dietz to the claim is provided in the Office Action. Therefore, *prima facie* anticipation has not been established.

Claim 1 further provides the processing circuit configured to (ii) present an outgoing packet containing the second parameter. Despite the assertion on page 5 of the Office Action, Dietz appears to be silent regarding the network monitor 300 (implied similar to the claimed processing circuit) presenting an outgoing packet containing a second parameter (produced internally by the network monitor 300 using a pointer from the CAM and an incoming packet) as presently claimed. Furthermore, no application of Dietz to the claim is provided in the Office Action. Therefore, *prima facie* anticipation has not been established. As such, the Examiner is respectfully requested to either (i) provide a clear and concise explanation how the cited figures and paragraphs of Dietz allegedly anticipate the claim limitations or (ii) withdraw the rejection to claim 1.

Claim 10 provides a second circuit configured to (i) store a pointer for each first parameter of a network protocol.

Despite the assertion on page 5 of the Office Action, Dietz appears to be silent regarding the network monitor 300 (implied similar to the claimed second circuit) storing a pointer for parameters for a network protocol as presently claimed. Furthermore, no application of Dietz to the claim is provided in the Office Action. Therefore, *prima facie* anticipation has not been established.

Claim 10 further provides the second circuit is configured to (ii) process at least one first parameter in the incoming packet in accordance with the pointer to produce a second parameter. Despite the assertion on page 6 of the Office Action, Dietz appears to be silent regarding the network monitor 300 (implied similar to the claimed second circuit) processing parameters in accordance with a pointer (stored in the network monitor 300) to produce a second parameter as presently claimed. Furthermore, no application of Dietz to the claim is provided in the Office Action. Therefore, *prima facie* anticipation has not been established.

Claim 10 further provides the second circuit is configured to (iii) present an outgoing packet containing the second parameter. Despite the assertion on page 6 of the Office Action, Dietz appears to be silent regarding the network monitor 300 (implied similar to the claimed second circuit) presenting an outgoing packet containing a second parameter (produced internally in accordance with a pointer stored in the network monitor 300 and

the incoming packet) as presently claimed. Furthermore, no application of Dietz to the claim is provided in the Office Action. Therefore, *prima facie* anticipation has not been established.

Claim 10 further provides a third circuit configured to frame the outgoing packet to present a transmit frame to a second network. Despite the assertion on page 6 of the Office Action, FIG. 15 and the cited text of Dietz appear to be silent regarding an unidentified circuit framing an outgoing frame (received from the network monitor 300) to present a transmit frame to a second network as presently claimed. Furthermore, no application of Dietz to the claim is provided in the Office Action. Therefore, *prima facie* anticipation has not been established. As such, the Examiner is respectfully requested to either (i) provide a clear and concise explanation how the cited figures and paragraphs of Dietz allegedly anticipate the claim limitations or (ii) withdraw the rejection to claim 10.

Regarding claims 2-9 and 11, the Office Action fails to provide evidence that Dietz expressly or inherently discloses the dependent claims. Instead, the Office Action repeatedly cites the same figures and paragraphs of text of Dietz with no explanation how the cited information anticipates the claims. Therefore, *prima facie* anticipation has not been established. As such, the Examiner is respectfully requested to either (i) provide a clear and concise explanation how the cited figures and paragraphs of

Dietz allegedly anticipate the claim limitations or (ii) withdraw the rejection to claims 2-9 and 11.

Regarding claims 12-17, the Office Action fails to provide any evidence or arguments that the claims 12-17 are anticipated by Dietz. Claims 12-17 do not provide language similar to the claims 1-10 as implied on page 8 of the Office Action. Therefore, simply referring to the rejections of claims 1-10 does not explain why the unique claims 12-17 are rejected. As such, *prima facie* anticipation has not established and the rejection of claims 12-17 should be withdrawn.

COMPLETENESS OF THE OFFICE ACTION

Aside from a notice of allowance, Applicant's representative respectfully requests any further action on the merits be presented as a non-final action. 37 CFR §1.104(b) states:

(b) *Completeness of examiner's action.* The examiner's **action will be complete as to all matters**, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters of form need not be raised by the examiner until a claim is found allowable. (Emphasis added)

No substantive arguments were presented in the Office Action. directed to claims 12-17. As such, the Office Action is incomplete.

INFORMATION DISCLOSURE STATEMENT

The Examiner is respectfully requested to consider, sign and return the PTO-1449 forms filed 21 June 2002, 28 August 2003 and 30 April 2004.

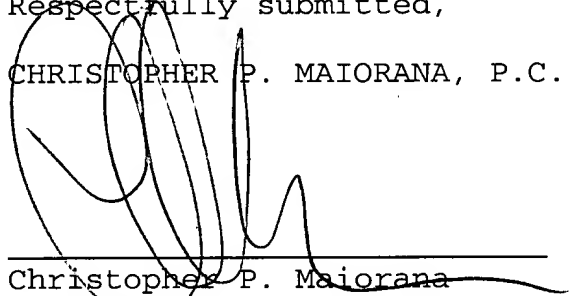
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 50-0541.

Respectfully submitted,

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